

Appl. No. : 10/695,636
Filed : October 28, 2003

REMARKS

Claim 1 has been amended to more clearly state what the Applicants consider as their invention. Support for these amendments may be found in the specification, for example, in paragraphs 188, 196, 202 – 205 and 210 – 216. Claims 1-26 and 135-139 are pending in the application. The Applicants have carefully considered all of the Examiner's rejections but respectfully submit that the claims are allowable for at least the following reasons.

Rejections under § 112

The Examiner rejected Claims 1-26 and 135-139 under 35 U.S.C. § 112, first paragraph, as failing to comply with the written description requirement, arguing that the negative proviso requiring “that the silicone composition is not produced from a precursor diisocyanate” was not supported by the specification. Applicants have amended independent Claim 1 to delete the proviso. Accordingly, Applicants respectfully submit that independent Claim 1 and dependent Claims 2-26 and 135-139 are supported by the specification and wholly comply with 35 U.S.C. § 112.

Rejections under § 102

The Examiner rejected Claims 1-12, 17-26, 138 and 139 under 35 U.S.C. § 102(e) as being anticipated by U.S. Patent No. 6,528,584 (Kennedy). “A claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference.” M.P.E.P. § 2131 (quoting *Verdegaal Bros. v. Union Oil Co. of California*, 814 F.2d 621, 631 (Fed. Cir. '1987)). The Examiner argued that Kennedy met the “controls transport of an analyte” limitation of Claim 1 by disclosing that its membrane was permeable to water, hydrocarbons, and oxygen. Applicants have amended Claim 1 to recite that the silicone composition is configured to “resist diffusion of an analyte.” Kennedy does not disclose that its membrane material has the necessary properties to resist diffusion of an analyte through the membrane and the Examiner has not provided “a basis in fact and/or technical reasoning to reasonably support [a] determination that” these properties are inherently present. See M.P.E.P. § 2112(IV). Accordingly, the Applicants respectfully submit that Claims 1-12, 17-26, 138 and 139 are not anticipated by Kennedy.

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Although the claims do not currently stand rejected over U.S. Patent No. 5,777,060 (Van Antwerp), the Applicants are addressing this reference in light of their deletion of the proviso in Claim 1. Claim 1 as amended recites that the silicone composition “comprises a silicone polymer comprising an alternating silicon and oxygen atom backbone, wherein terminal groups of the backbone are selected from optionally substituted alkyl, alkenyl, aryl or aralkyl.” Van Antwerp does not disclose an alternating silicon and oxygen atom backbone having terminal groups selected from optionally substituted alkyl, alkenyl, aryl or aralkyl. Instead, the polymers disclosed in Van Antwerp contain urea and urethane linkages such that the chemical species on at least one terminal end of the silicon and oxygen backbone region do not fall within the claimed terminal groups. As such, the Applicants respectfully submit that Van Antwerp does not anticipate Claims 1-26 and 135-139.

The Examiner also rejected Claims 1-5, 7, 8, 10, 11, 17-19, 138 and 139 under 35 U.S.C. § 102(e) as being anticipated by U.S. Application Publication No. 2003-0059631 (Al-Lamee). The Examiner argued that Al-Lamee met the “controls transport of an analyte” limitation of Claim 1 by noting that “the teachings in Al-Lamee are drawn to membranes formed on oxygenators, which have oxygen permeability, blood filters and glucose monitoring devices (which immobilize or control the transport of glucose).” As discussed above, Applicants have amended Claim 1 to recite that the silicone composition is configured to “resist diffusion of an analyte.” Al-Lamee does not disclose that its membrane material has the necessary properties to resist diffusion of an analyte through the membrane. As such, the Applicants respectfully submit that Claims 1-5, 7, 8, 10, 11, 17-19, 138 and 139 are not anticipated by Al-Lamee.

Finally, the Examiner rejected Claims 1-12, 17, 19-26, 138 and 139 under 35 U.S.C. § 102(b) as being anticipated by U.S. Patent No. 4,260,725 (Keogh et al.). The Examiner argued that Keogh met the “controls transport of an analyte” limitation of Claim 1 by noting that the membranes taught in Keogh “have good oxygen permeability” and “by transporting oxygen, the membranes therein *control* the transport of oxygen.” As discussed above, Applicants have amended Claim 1 to recite that the silicone composition is configured to “resist diffusion of an analyte.” Keogh does not disclose that its membrane material has the necessary properties to resist diffusion of an analyte through the membrane. As such, the Applicants respectfully submit that Claims 1-12, 17, 19-26, 138 and 139 are not anticipated by Keogh.

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Rejections under § 103

The Examiner rejected Claims 13 and 15 under 35 U.S.C. § 103(a) as being obvious over Al-Lamee. A *prima facie* case of obviousness requires that all of the claim limitations are taught or suggested by the prior art. *See* M.P.E.P. § 2143.03. As discussed above, Al-Lamee does not disclose all of the limitations of independent Claim 1 as amended. Accordingly, the Applicants respectfully submit that Al-Lamee does not teach or suggest all of the limitations of dependent Claims 13 and 15.

CONCLUSION

The Applicants respectfully submit that, by the foregoing amendments and remarks, they have overcome all of the rejections and request a timely issuance of a Notice of Allowance.

Please charge any additional fees, including any fees for additional extension of time, or credit overpayment to Deposit Account No. 11-1410.

Respectfully submitted,

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